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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,301	08/04/2005	Jonathan Hughes	IA/3-22334/PCT	7941
324 7590 09/05/2008 JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591				
EXAMINER HRUSKOCI, PETER A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,301

Applicant(s)

HUGHES ET AL.

Examiner

/Peter A. Hruskoci/

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The disclosure is objected to because of the following informalities: In the specification on page 1 "aluminium" is erroneous.

Appropriate correction is required.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 "characterized by a treatment system" is vague and indefinite because it is unclear how this term further limits the claim. Claims 2-19 depend from the above claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 13, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brink 5,536,325 in view of the Minowa et al. publication "The Characteristics Of Dewatering Ethanol Fermentation Stillage". Brink disclose (see col. 5 line 38 through col. 6 line 60 and col. 9 line 11 through col. 11 line 34) a process for separating suspended solids from a fermentation liquor substantially as claimed. It is submitted that the liquor removed from the distillation stage in Brink would comprise water, lignin and BOD. The claims differ from Brink by reciting the use of a specific treatment system in the separation stage. Minowa et al. disclose (see Abstract) that it is known in the art to add cationic and anionic polymeric coagulants to aid in dewatering ethanol fermentation stillage. It would have been obvious to one skilled in the art to modify the process of Brink by utilizing the recited treatment system in view of the teachings of Minowa et al., to aid in dewatering solids in the separation stage. The use of the separation

stage prior to the distillation stage, and the specific dose of coagulant utilized, would have been an obvious matter of process optimization, depending on the specific liquor treated and results desired, absent a sufficient showing of unexpected results.

Claims 4-6, 8-12, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brink 5,536,325 in view of the Minowa et al. publication "The Characteristics Of Dewatering Ethanol Fermentation Stillage" as above, and further in view of Hughes et al. 6,967,085. The claims differ from the references as applied above by reciting the treatment system includes specific polymers and coagulants. Hughes et al. disclose (see col. 1 lines 16-60, and col. 3 line 33 through col. 7 line 38) that it is known in the art to add the recited polymers and coagulants to aid in flocculating and separating cell or solid material from fermentation broths. It would have been obvious to one skilled in the art to modify the references as applied above, by utilizing the recited polymers and coagulants in view of the teachings of Hughes et al., to aid in dewatering solids in the separation stage. The specific intrinsic viscosities and dose utilized, would have been an obvious matter of process optimization, depending on the specific liquor treated and results desired, absent a sufficient showing of unexpected results. With regard to claims 15 and 16, it is submitted that Hughes et al. as applied above, disclose the use of centrifuge or filter in the separation stage or step.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brink 5,536,325 in view of the Minowa et al. publication "The Characteristics Of Dewatering Ethanol Fermentation Stillage" as above, and further in view of Moffett 6,132,625. The claim differs from the references as applied above by reciting that the coagulant is a charged microparticulate material. Moffett disclose (see col. 3 line 3 through col. 6 line 39) that it is known in the art to add a

flocculating agents and anionic microgels, to aid in flocculating biosolids present in aqueous streams from distilleries including sugars and carbohydrates. It would have been obvious to one skilled in the art to modify the references as applied above by addition of the recited microparticulate material in view of the teachings of Moffett, to aid in dewatering solids in the separation stage.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brink 5,536,325 in view of the Minowa et al. publication "The Characteristics Of Dewatering Ethanol Fermentation Stillage" as above, and further in view of Chieffalo et al. 5,975,439. The claim differs from the references as applied above by reciting that the dewatered solids are subjected to a drying stage and used as solid fuel. Chieffalo et al. disclose (see col. 6 lines 40-64 and col. 36 lines 18-55) that it is known in the art to dewater and dry solids including lignin, and utilize the solids as a fuel. It would have been obvious to one skilled in the art to modify the references as applied above by utilizing the recited drying stage in view of the teachings of Chieffalo, to aid in producing a fuel from the dewatered solids.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/587,582 and claims 1-22 of copending Application No. 10/587,583. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process steps recited in the instant claims appear to be fully encompassed by the claims of the copending applications, respectively.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants argue that the fermentation liquor of Brink does clearly not comprise lignin, contrary to the fermentation liquor of the present process. It is noted that the process of Brink includes the hydrolysis of a lignocellulosic material. It would appear that the finely dispersed or undissolved solids separated from the fermentation liquor of Brink would include solids comprising at least some lignin and BOD as in the instant process. It is further noted that the neutralized mixture of Brink is not excluded from the instant claims. Furthermore, applicants have not provided sufficient factual evidence to support the above argument.

Applicant alleges that at the stage of fermentation in Brink there is neither a disclosure nor a suggestion how the solids-liquid separation of the fermentation liquor is carried out, and does not mention any use of a treatment system as claimed in the present invention. It is submitted that Brink as applied above discloses the use of a solids separation stage of a fermentation liquor or stillage after a distillation or rectification stage. It is noted that Minowa et

al. as applied above was used to teach that it is known in the art of liquid purification to add cationic and anionic polymers to aid in separating a fermentation stillage. It would have been obvious to one skilled in the art having the teachings of Brink and Minowa et al. before him, to modify the process of Brink by utilizing the recited treatment system in view of the teachings of Minowa et al., to aid in dewatering solids in the separation stage. Furthermore, applicants have not supplied sufficient comparative evidence with the teachings of Brink and Minowa et al. to support the above allegation.

Applicants argue that Minowa et al. does not teach or suggest the specific treatment system which comprises a cationic polymer having an intrinsic viscosity of at least 4 dl/g in combination with one or more coagulants defined as (iii) to (vi), as used in the present invention as recited in claim 1. It is submitted that instant claim 1 does not appear to be limited to the use of the recited cationic polymer. It is noted that the term “and/or” recited in line 11 of claim 1 appears to include the alternative use of (iv), (v), and (vi), instead of the cationic polymer and (iii) anionic polymer.

Applicants allege that the instant process is particularly effective when the treatment system comprises a second component in addition to the cationic coagulant as disclosed on page 6 second paragraph of the instant specification. It is submitted the separation process disclosed on page 6 of the specification has been carefully considered but fails to overcome the above rejections. It is noted that this separation process appears to utilize specific polymers and components, and separation conditions which are not commensurate with the scope of the instant claims. Furthermore, applicants have not submitted sufficient comparative evidence with the prior art used in the above rejections to support the above allegation.

Applicants' arguments concerning Hughes, Moffett, and Chieffalo, appear to be based on the propriety of the combination of Bring and Minowa et al.. This combination is deemed properly applied for reasons stated above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Peter A. Hruskoci/ whose telephone number is (571) 272-1160. The examiner can normally be reached on Monday through Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter A. Hruskoci/
Primary Examiner
Art Unit 1797

9/2/08